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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,505	02/17/2004	Christine Vadai	41826.8005US	7872
45979	7590	01/22/2007		
PERKINS COIE LLP/MSFT P. O. BOX 1247 SEATTLE, WA 98111-1247			EXAMINER LEWIS, CHERYL RENE A	
			ART UNIT	PAPER NUMBER
			2167	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/22/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/780,505

Applicant(s)

VADAI ET AL.

Examiner

Cheryl Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13,15,16,20-26 and 30-43 is/are rejected.
- 7) ☒ Claim(s) 14,17-19 and 27-29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/26/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the applicant's communication received on October 26, 2006.
2. Claims 1-43 are presented for examination.
3. Applicant's arguments with respect to claims 1-43 have been considered but are moot in view of the new grounds of rejection.

Remarks

4. The examiner apologizes for not providing clarity in the 35 U.S.C. § 101 rejection cited in the office action dated July 26, 2006. Therefore, clarity for the 35 USC § 101 rejection is presented in the office action below.

Allowable Subject Matter

5. Claims 14, 17-19, and 27-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 31 and 39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As follows:

Claims 31 and 39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 31 is directed to collecting failed queries, selecting some of the collected queries related to a topic, and modifying the entry of the topic based on the selected query. Claim 39 is directed to a title for a topic, data derived from failed queries, and content describing the topic. The claimed inventions, as a whole must accomplish a **practical application**. That is, it must produce a **“useful, concrete, and tangible result.”** *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. *MPEP* 2106. In each of these cases the **result** for claim 31 is modifying an entry for a topic and the **result** for claim 39 is having a title topic, deriving data from failed queries, and having content describing a topic. The claimed limitations are an abstraction as they are not **useful, concrete, and tangible**, they are not put in any tangible form and not useful because they are not presented in a way to provide some result that is of utility that may exist in the specification however no specific use is provided for in the claimed invention. Thus the claims are non-statutory and stand rejected under 101 as not **producing a “useful, concrete, and tangible result.”**

Claim 39 is not limited to tangible embodiments. In view of Applicant's disclosure, publication no. 20050182783, paragraph [0028], the medium is not limited to tangible embodiments, instead being defined as intangible embodiments (e.g., [signal]). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

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To overcome this type of 101 rejection the claims need to be amended to include only the physical computer media. The Examiner recommends that the applicants kindly amend claims 39-43 to recite a "computer-readable storage medium" in an effort to make the claims statutory.

Further, claims 31 and 39 do not include any physical transformation or manipulation of the claimed data to produce a useful, concrete, and tangible result (AT&T, 172 F.3d at 1358-59, 50 USPQ2d at 1452. MPEP 2106 Rev. 5, Aug. 2006). At best claim 31 modifies the help file, but after the help file has been modified then what happens to the updated data belonging to the help file as a result of the modification being made. As to claim 39, it is at best descriptive of a title to a topic and contents of a topic being comprised within the help file. Claims 31 and 39 do not consist of any of the statutory elements presented in claim 35. For example, claim 35 consists of making an entry to the help file, each entry having a title, receiving a user query, searching the help file for a topic that matches the received user query, a match determined based on a comparison of the received user query to the data derived from failed user queries (useful, concrete, and tangible result).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-13, 15, 16, 20-26, and 30-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Morrow et al. (Patent No. 6,983,271 B2 filed June 13, 2001, hereinafter Morrow).

10. Regarding Claims 1, 21, 31, 35, and 39, Morrow teaches an answer wizard drop-down control.

The method and associated system for an answer wizard drop-down control as taught or suggested by Morrow includes:

collecting (figure 1, element 310 'edit/drop control module'; col. 7, lines 37-40, '...the user may go back to previous questions to obtain help topics related to those questions without reentering the questions...', col. 7, lines 50-53, 'When the user does type in a new query in the edit control, the edit/drop-down control module 310 may then invoke the list of previously entered strings to find one that is similar to the user's new query.') failed user queries (col. 8, lines 53-57, 'If at step 650, the user does not find any of the potential answers acceptable, the method proceeds along the "No" branch back to step 615, where the user may enter a new question, or where the user may modify the previously-entered question.');

receiving a selection of a topic (col. 6, lines 45-49, '...the answer wizard DLL 320 performs a search of available help topics contained in the help module...', col. 8, lines 9-11, '...for help topics related to the selected question.');

receiving a selection of some of the collected user queries (col. 7, lines 37-40 and 50-53, col. 8, lines 53-57);

modifying (col. 6, lines 35-38, '...the help file module

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330 and the balloon DLL 340 are utilized by the edit/drop-down control module 310 for providing the functionality of the answer wizard drop-down menu...) the help file (Abstract, lines 2 and 3, '...help files...') so that the selected topic is more likely identified as being relevant to the selected user queries (col. 6, lines 45-63, '...if the user enters the string "How do I print?," the answer wizard DLL 320 parses the question to find recognized keywords with to search the help topics contained in the help module 330...When the answer wizard DLL locates help topics in the help module related to the keyword "print," it returns to the edit/drop-down control module 310 a series of potential answers related to the keyword "print."").

11. Regarding Claims 2, Morrow teaches modifying includes adding data derived from the selected user queries to an entry of the selected topic (col. 5, lines 28-32 and 60-64, col. 6, line 2).

12. Regarding Claims 3, Morrow teaches the means which essentially comprises the same means as deriving data is added as metadata that is searched by a help system (col. 6, lines 45-63) when determining whether a topic matches a user query (col. 5, lines 59-67, col. 6, lines 1-9).

13. Regarding Claims 4, Morrow teaches a help system searches for topics that match a user query (col. 6, lines 45-63), the help system weights matches within the derived data of the topics more heavily than matches within the content of the topics (col. 6, lines 45-63).

14. Regarding Claim 5, Morrow teaches modifying includes adding data derived from the selected user queries to a search catalog of the help file (col. 7, lines 11-31).

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15. Regarding Claim 6, Morrow teaches the means which essentially comprises the same means as data is added as metadata that is searched by a help system when determining whether a topic matches a user query (col. 6, lines 45-63).

16. Regarding Claims 7 and 8, the limitations of these claims have been noted in the rejections above. They are therefore rejected as set forth above.

17. Regarding Claim 9, Morrow teaches collecting includes an indication of an application associated with the failed user query (col. 2, line 67).

18. Regarding Claim 10, Morrow teaches receiving a search criteria (col. 6, lines 45-67); and searching the collected user queries for those that match the received search criteria (col. 6, lines 45-67).

19. Regarding Claim 11, Morrow teaches displaying the matching user queries (col. 5, lines 15-17); and receiving a selection of some of the matching user queries (col. 5, lines 15-17).

20. Regarding Claims 12, 13, 15, 16, 20, 22-26, 30, 32-34, 36-38, and 40-43, the limitations of these claims have been noted in the rejections above. They are therefore rejected as set forth above.

NAME OF CONTACT

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Lewis whose telephone number is (571) 272-4113. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

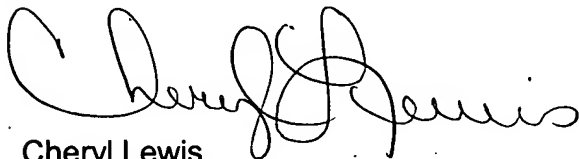
(571) 273-4113 (Use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper/amendment be faxed directly to them on occasions.).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/ Technology Center (571) 272-2100.

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Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cheryl Lewis
Patent Examiner
January 16, 2007